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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,152	03/23/2000	Michael J. Coar	2610-001	1127

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	09/533,152		COAR, MICHAEL J.	
	Examiner		Art Unit	
	Matthew J. Ludwig		2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-14 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Amendment received 1/9/06.
2. Claims 1, 7, and 13, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject has been withdrawn pursuant to applicant's amendment. Furthermore, claims 1-7, 9-14, and 16, rejected under 35 U.S.C. 102(e) as being anticipated by Burke has been withdrawn pursuant to applicant's amendment.
3. Claims 1-7, 9-14, 16-28 are pending in the application. Claims 1, 7, and 13, are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-7, 9-14, and 16-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., Pat. Pub. No. US 2005/0246541 filed (4/7/05).**

In reference to independent claim 1, Ginter teaches:

Item might be a document such as a handwritten or typed letter, or it could be a legal document such as a contract. It could have text and pictures, just text or just pictures. It could be a multimedia presentation (compare to "*acquiring a data file, wherein the data file comprises content useful in conducting the transaction*"). See Ginter, page 9, [0266] through [0268].

Sender might press a button corresponding to “delivery options”, based upon the electronic document. Receipt options, integrity guarantee options, and privacy options, are all information about the data file (compare to “*creating information about the data file*”). See Ginter, page 9, [0273] through [0279]. As presently claimed, information about the data file, is broadly interpreted by the Examiner and is suggested in the delivery options based upon the delivery of electronic data.

Electronic appliance may also ask the user to identify intended recipient. Sender may select different ways to identify recipient based on the confidentiality of the document and level of security the sender is willing to pay for (compare to “*associating the information about the data file with the data file*”). See Ginter, page 9, [0273] through [0279]. The Examiner believes the fact that information is brought to the user’s attention based upon the electronic information he or she wishes to send suggests associating the information about the data file with the data file. The reference suggests options for the user to select which would suggest a means of associating information about the data file with the data file.

Sender may also specify the electronic address of recipient, or it might let system automatically, securely and confidentially locate the recipient using a secure directory service (compare to “*assigning a unique transaction identifier to the transaction*”). See Ginter, page 10, [0282] through [0283].

Appliance may then package the digital form of document into secure electronic container and send it over electronic network for secure delivery to recipient (compare to “*forming an electronic container by storing data file and the information about the data file with other data files*”). See Ginter, page 11, [0290] through [0291].

Electronic appliance may also ask the user to identify intended recipient. Sender may select different ways to identify recipient based on the confidentiality of the document and level of security the sender is willing to pay for. On one example, sender might require the recipient's appliance to require recipient to prove that he/she is who he/she says they are. This secure "authentication" function might be met by, for example, requiring recipient to input a password (compare to "*access rules established in the information about the data file and the information about other data files*"). See Ginter, page 10, [0279] through [0283].

The reference fails to explicitly state that the container is formed by storing the data file and information about the data file with other data files *and information about the other data files having the same unique transaction identifier*. However, the reference provides a method of scanning not only documents, but also states the item could be any type of item capable of being transformed into digital form, such as pictures or other graphical information, sound information, video, multimedia, or any combination/subcombination of the above. The examiner believes the reference suggests the well-known methods of storing multiple files within a container based upon the selection of one unique home address. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the various information content taught by Ginter and delivered such content within an electronic container, because it would have given the user the added benefit of having one address for delivery of multiple content files.

In reference to dependent claim 2, Ginter teaches:

The sender's electronic appliance and the recipient's electronic appliance can report their respective "audit trails" periodically or upon completion of delivery or some other event. See Ginter, page 12, [0034].

In reference to dependent claim 3, Ginter teaches:

Privacy options (for example, whether recipient is to know who sender is or where she has sent the document from); See Ginter, page 10, [0273] through [0279].

In reference to dependent claim 4, Ginter teaches:

Privacy options (for example, whether recipient is to know who sender is or where she has sent the document from); See Ginter, page 10, [0273] through [0279].

In reference to dependent claim 5, Ginter teaches:

Each of the contracting parties may be required to securely identify themselves by, for example, inserting a card into a card reader and/or by allowing a biometric sensor to scan a part of their body such as a finger print or a retina pattern, thereby proving that they are who they say they are. See Ginter, page 13, [0316].

In reference to dependent claim 6, Ginter teaches:

Trusted go-between acts as an impartial overseer who can document a transaction, and may also become actively involved in directing the transaction to see to it that it is completed properly. Trusted electronic go between may provide valuable third party services such as, maintaining a secure archive of data, receipts and other information about transmissions senders sends to recipients; managing the transaction for example, so that not all parties need to

participate simultaneously or to ensure that all prerequisites or preconditions have been satisfied). See Ginter, page 13, [0324] through [0327].

In reference to claims 7, 9-12, the claims reflect the system comprising computer readable instructions used for performing the methods as claimed in 1-6. In further view of the following, the claims are rejected under similar rationale.

In reference to independent claim 13, Ginter teaches:

The limitations as disclosed in the rejection of independent claim 1. The limitations seem to be worded differently, however, they do not overcome the Ginter reference. The claim includes a limitation regarding “extracting routing information associated with the data file from the information about the data file”. Ginter discloses privacy options (for example, whether recipient is to know who sender is or where she has sent the document from); See Ginter, page 10, [0273] through [0279]. Also, the sender provides a home address, which is extracted and used as routing information associated with the data file. Electronic appliance may also ask the user to identify intended recipient. Sender may select different ways to identify recipient based on the confidentiality of the document and level of security the sender is willing to pay for. On one example, sender might require the recipient’s appliance to require recipient to prove that he/she is who he/she says they are. This secure “authentication” function might be met by, for example, requiring recipient to input a password (compare to “*access rules established in the information about the data file and the information about other data files*”). See Ginter, page 10, [0279] through [0283].

The reference provides a secure container including one or more routing slips and one or more audit trails. Routing slip and audit trail are data structures defined by and/or associated with

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electronic controls and may be integrated as part of these electronic controls. The reference fails to explicitly state that routing information for processing the data file, wherein the recipient may process the data file according to processing rules; however the well known routing data structures taught by Ginter would have provided a sender with the appropriate means for delivering specific content information to individuals. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to utilize the routing methods taught by Ginter to provide routing information to a sender/recipient to allow joint parties to examine and sign proposed contracts in a network environment.

In reference to dependent claim 14, Ginter teaches:

The item could be any type of item capable of being transformed into digital form, such as pictures or other graphical information, sound information, video, multimedia, or any combination/subcombination of the above. The examiner believes the reference suggests the well-known methods of storing multiple files within a container based upon the selection of one unique home address. See Ginter, page 11, [0284] through [0285].

In reference to dependent claim 16, Ginter teaches:

The sender's electronic appliance and the recipient's electronic appliance can report their respective "audit trails" periodically or upon completion of delivery or some other event. See Ginter, page 12, [0034].

In reference to dependent claim 17, Ginter teaches:

Trusted delivery mechanism may send messages such as offers and acceptances between the two electronic appliances. These messages may be packaged within secure electronic containers. See Ginter, page 13, [0318] through [0319].

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In reference to dependent claim 18, Ginter teaches:

Trusted electronic go-between may deliver a copy of item with the affixed seal to recipient. When recipient opens the secure electronic container, he will notice the seal and have confidence that it is the same item that was seen and archived by the trusted electronic go-between. See Ginter, page 14, [0329] through [0332].

In reference to dependent claim 19, Ginter teaches:

Secure container may also contain an electronic, digital control structure. This control structure (which could also be delivered independently in another container different from the one carrying the image and/or the data may contain important information controlling use of container. See Ginter, page 15, [0344] through [0346].

In reference to dependent claim 20, Ginter teaches:

Secure container may also contain an electronic, digital control structure. This control structure (which could also be delivered independently in another container different from the one carrying the image and/or the data may contain important information controlling use of container. See Ginter, page 15, [0344] through [0346].

In reference to dependent claim 21, Ginter teaches:

Information controlling use of container and under what conditions the container can be opened. Controls might also specify whom, if anyone, object can be passed on to. As another example, controls might specify restrictions on how the image and/or data can be used (to allow the recipient to view but not change the image and/or data as one example. See Ginter, page 15, [0346] through [0347].

In reference to dependent claim 22, Ginter teaches:

Currently, businesses often prefer simultaneous execution of documents at what is called a “closing”. Such closings for important documents frequently require the presence of all participants at the same location. See Ginter, page 13, [0315] through [0316].

In reference to dependent claim 23, Ginter teaches:

The item could be any type of item capable of being transformed into digital form, such as pictures or other graphical information, sound information, video, multimedia, or any combination/subcombination of the above. See Ginter, page 11, [0284] through [0285].

In reference to dependent claim 24, Ginter teaches:

Currently, businesses often prefer simultaneous execution of documents at what is called a “closing”. Such closings for important documents frequently require the presence of all participants at the same location. See Ginter, page 13, [0315] through [0316].

In reference to dependent claim 25, Ginter teaches:

Information controlling use of container and under what conditions the container can be opened. Controls might also specify whom, if anyone, object can be passed on to. As another example, controls might specify restrictions on how the image and/or data can be used (to allow the recipient to view but not change the image and/or data as one example. See Ginter, page 15, [0346] through [0347].

In reference to dependent claim 26, Ginter teaches:

The item could be any type of item capable of being transformed into digital form, such as pictures or other graphical information, sound information, video, multimedia, or any combination/subcombination of the above. See Ginter, page 11, [0284] through [0285].

In reference to dependent claim 27, Ginter teaches:

Currently, businesses often prefer simultaneous execution of documents at what is called a “closing”. Such closings for important documents frequently require the presence of all participants at the same location. See Ginter, page 13, [0315] through [0316].

In reference to dependent claim 28, Ginter teaches:

Information controlling use of container and under what conditions the container can be opened. Controls might also specify whom, if anyone, object can be passed on to. As another example, controls might specify restrictions on how the image and/or data can be used (to allow the recipient to view but not change the image and/or data as one example. See Ginter, page 15, [0346] through [0347].

Response to Arguments

6. Applicant's arguments with respect to claims 1-7, 9-14, and 16 have been considered but are moot in view of the new ground(s) of rejection. Applicant has added claim language and newly formed limitations into both the independent claims and dependent claims. The newly formed subject matter changes the scope of the invention when read as a whole and therefore required the Examiner to search and draft a newly formed rejection accordingly. More specifically, applicant added the formation of a container and providing the electronic container to a participant of the transaction, wherein the participant may access the data file and other data files in accordance with access rules established in the information about the data file and the information about the other data files. Finally, the applicant added associating the data file and

the information about the data file with the transaction identifier. The above-mentioned limitations change the scope of the claim and required the examiner to modify the rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

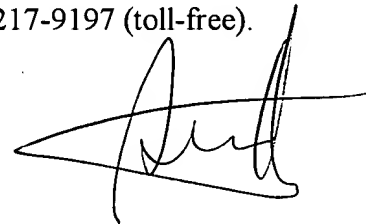
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
March 30, 2006

A handwritten signature in black ink, appearing to read 'Stephen Hong', with a large, sweeping horizontal stroke extending to the left.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER